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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,946	06/22/2001	Mark P. Ashby	018413-331	9583

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EXAMINER

COZART, JERMIE E

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/806,946	ASHBY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jermie Cozart	3726	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/12/05 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 15 and 17 each contain the trademark/trade name TEFLON. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or

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trade name. In the present case, the trademark/trade name is used to identify/describe a flouropolymer and, accordingly, the identification/description is indefinite,

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muni et al. (6,190,232) in view of Cheetham (5,674,106).

Muni`332 discloses a guide wire (10) having a substantially cylindrical mandrel (26), wherein the mandrel has one or more segments (28, 46) each having a uniform initial diameter not exceeding a maximal diameter. Muni`332 discloses providing a wire (26) of a diameter greater than the maximal diameter as shown in Figure 3A, and reducing the diameter of the wire to less than maximal diameter such that a mandrel (26) is obtained whose diameter is less than the maximal diameter over substantially the entire length of the mandrel (26) as shown in Figures 3A-3C and disclosed in column 5, line 47 – column 6, line 13. Muni`332 discloses the step of reducing comprising center-less grinding, and a coil (32) being affixed to the mandrel, wherein the coil is radiopaque. The wire (26) is made of stainless steel (col. 4, line 66 – col. 5, line 1). *See column 5, lines 14 – 27; column 6, lines 7-13; and Figures 2 – 3C for further clarification.*

Muni`332, however, does not disclose reducing by center-less grinding the initial diameter of the wire to a diameter not exceeding the maximal diameter of the guidewire.

Cheetham discloses reducing by center-less grinding the initial diameter of the wire (48) to a diameter not exceeding the maximal diameter of the finished wire, in order accurately produce the desired taper of the work-piece profile. *See entire document for further clarification, especially column 11, line 27 – column 12, line 55 and figures 1 and 6-8 for further clarification.*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to reduce by center-less grinding the initial diameter of the wire of Muni`332 to a diameter not exceeding the maximal diameter, in light of the teachings of Cheetham, in order accurately produce the desired taper of the work-piece profile (i.e. wire).

7. Claims 3, 8, 9, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muni`332/Cheetham as applied to claim 1 above, and further in view of Cornish et al. (6,132,389).

Muni`332/Cheetham as modified above discloses all of the claimed subject matter except for the step of coating at least a portion of the mandrel with a hydrophilic coating, coating the mandrel with a lubricious coating, wherein the lubricious coating is applied to all but a proximal portion of the mandrel, the lubricious coating being a hydrophilic coating such as TEFLON (polytetrafluoroethylene).

Cornish`389 discloses coating at least a portion of mandrel (12) with a hydrophilic coating, and coating the mandrel with a lubricious coating (26) being a hydrophilic coating such as TEFLON (polytetrafluoroethylene), wherein the lubricious coating may optionally be applied is applied to any additional portion. *See column 3, lines 34 – 60, and Figures 1 and 4 for further clarification.*

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to coat at least a portion of the mandrel of Muni`332/Cheetham with a hydrophilic coating, and to coat the mandrel of Muni`332/Cheetham with a lubricious coating, wherein the lubricious coating is optionally applied to selective portions, in light of the teachings of Cornish`389, in order to effectively reduce the surface friction of the mandrel.

8. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muni`332/Cheetham as applied to claim 1 above, and further in view of Applicant's Admitted Prior Art (AAPA).

Muni`332/Cheetham as modified above discloses all of the claimed subject matter except for the step of providing a wire comprising unwinding the wire from a spool, straightening the wire, or cutting the wire to a desired length.

AAPA at page 1 of the specification that it is known in the method of manufacturing a guide wire to select a single drawn/spooled wire, straighten the spooled wire, and cut the wire to the desired length.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to select the wire of Muni`332/Cheetham from a single drawn/spooled wire, straighten the spooled wire, and cut the wire to the desired length, in light of the teachings of AAPA, in order to effectively deliver and provide a uniform starting material for the core section of the guide wire.

9. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muni`332 in view of Applicant's Admitted Prior Art (AAPA).

Muni`332 discloses all of the claimed subject matter except for the step of providing a wire comprising unwinding the wire from a spool, straightening the wire, or cutting the wire to a desired length.

AAPA at page 1 of the specification that it is known in the method of manufacturing a guide wire to select a single drawn/spooled wire, straighten the spooled wire, and cut the wire to the desired length.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to select the wire of Muni`332 from a single drawn/spooled wire, straighten the spooled wire, and cut the wire to the desired length, in light of the teachings of AAPA, in order to effectively deliver and provide a uniform starting material for the core section of the guide wire.

10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muni`332/AAPA as applied to claim 11 above, and further in view of Cornish et al. (6,132,389).

Muni`332/AAPA as modified above discloses all of the claimed subject matter except for the step of treating the guidewire with a lubricious compound such as TEFLON (polytetrafluoroethylene).

Cornish`389 discloses the step of treating the guidewire (12) with a lubricious coating (26) such as TEFLON (polytetrafluoroethylene). *See column 3, lines 34 – 60, and Figures 1 and 4 for further clarification.*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to treat the guidewire of Muni`332/AAPA with a lubricious compound

such as TEFLON (polytetrafluoroethylene), in light of the teachings of Cornish`389, in order to effectively reduce the surface friction of the guidewire.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1 and 3-9, 16, and 17 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments filed 1/12/05 with respect to claims 10-15 have been fully considered but they are not persuasive.

Applicant argues that the amendments, requiring the guidewire be center-less ground along its entire length obviates the rejection.

In response, the Examiner maintains that this amendment pertains to claim 1 and affects claims 6 and 7, and as such a new grounds of rejection has been formulated for claims 1, 6, and 7. There has been no amendment to claims 10-15 which affect the scope of the claims 10-13, therefore the previous rejection of these claim has been maintained. Applicant has no provided specific arguments as to the deficiencies of the cited combination.

Applicant argues that the use of the trademark name TEFLON is definite in claim 15 based on M.P.E.P 608.01(v).

In response, the Examiner maintains that the use of trademarks is permissible in the specification if the description of the trademark name meets the criteria set forth in M.P.E.P 608.01(v), however, **the use of trademark names is not permissible in the claims.**



***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jermie Cozart  
Examiner  
Art Unit 3726